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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,336	05/25/2001	Toshitaka Yoshihiro	SON-2137	2332

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RADER, FISHMAN & GRAUER, P.L.L.C
1233 20th Street, NW, Suite 501
Washington, DC 20036

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/864,336	Applicant(s) YOSHIHIRO ET AL.	
	Examiner SHIBRU HELEN	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/25/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The specification is objected to because of the following informalities: on page 20 the forth line from the bottom, the word 'BS' should be changed to 'SB'.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim is computer related processes which do not have any physical transformation outside the computer nor be limited to a practical application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 10, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane (US Pat. No. 5,740,307).

Regarding claim 1, Lane discloses a magnetic tape tracking control apparatus for controlling tracking of tracks on a magnetic tape by a rotary head, comprising:

Art Unit: 2616

a first generating (see fig.1 tuner/demodulator/trellis decoder/ deinterleaver R-S decoder (104)) means for encoding an inputted video signal to generate said video data (normal play) (see col. 3 lines 31-36, col. 4 lines 1-9 and col. 7 lines 26-32);

a second generating (see data selection circuit (108) in fig. 1) means for generating search video data (trick play) on the basis of said video said first generating means (see col. 5 lines 33-38); and

a recording means for recording, on said tracks said video data generated by said first generating means (see col. 4 lines 14-23), said search video data generated by second generating means (see col. 16 lines 52-56 and abstract lines 4-7) and positional information associated with a recording position of said search video data (see col. 5 lines 1-14 and lines 31-43, col. 6 lines 31-43 and 61-65).

Claim 10 is rejected for the same reason as discussed in claim 1 above.

Claim 22 is rejected for the same reason as discussed in claim 1 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane in view of Rijckaert (US Pat. No. 6,539,165).

Regarding claims 2 and 3, claims 2 and 3 differ from Lane in that the claims further require recording means records said video data in a unit of a sync block having a predetermined length and said positional information to a sync block which is different from a position of said search video data, and records said positional information to a subcode. Although Lane fails to disclose a unit of a sync block having a predetermined length and said positional information to a sync block which is different from a position of said search video data, Lane discloses the length of the sync block is predetermined (see col. 10 lines 45-57 and col. 20 lines 7-25).

In the same field of endeavor Rijckaert discloses recording means records said video data in a unit of a sync block having a predetermined length (see col. 4 lines 29-40). Rijckaert further discloses the position of the video data is different from the position of search video data (see col. 5 lines 3-32). Rijckaert further discloses recording means records said positional information to a subcode (see col. 4 lines 12-15). Therefore in light of the teaching in Rijckaert it would have been obvious to modify Lane by providing different position for the video data and the search video data and record positional information to a subcode in order to reproduce the data at the record carrier speed (see Rijckaert col. 5 lines 3-12).

Claim 23 is rejected for the same reason as discussed in claim 2 and 3 above.

7. Claims 4-9 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane in view of Kawamura (US 2001/0041055).

Regarding claim 4, claim 4 differ from Lane in that the claim further requires a first generating means for generating a first number corresponding a position of said tracks; second generating means for generating a second number corresponding a position of one of said tracks, recorded with search video data; and a comparing means for comparing said first number with

said second number to control tracking on the basis of a result of the comparison. Although Lane does not specifically disclose comparing means for comparing said first number with said second number to control tracking on the basis of a result of the comparison, lane discloses first generating means for generating a first number corresponding a position of said tracks (see col. 14 line 63-col. 15 line 3). Lane further discloses second generating means for generating a second number corresponding a position of one of said tracks, recorded with search video data (see col. 14 lines 51-56).

In the same field of endeavor Kawamura discloses a first generating means for generating a first number corresponding a position of said tracks (see paragraph 0131 lines 1-4); second generating means for generating a second number corresponding a position of one of said tracks (see col. 9 paragraph 0131 lines 5-7) , recorded with search video data; and a comparing means for comparing said first number with said second number to control tracking on the basis of a result of the comparison (see col. 9 paragraph 0131 lines 7-11). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lane by providing a comparator in order to move the pick up toward the specified track number.

Regarding claim 5, Lane discloses second generating means comprising, a counting means for counting clocks (PCR values) (see col. 5 lines 14-15 and col. 7 lines 62-65);

a detecting means for detecting a track recorded with said search video data (see col. 5 lines 14-15 and col. 7 lines 62-65) ; and

first setting means for setting count value of said counting means on the basis of a detection result by said detecting means (see col. 5 lines 14-19, the counted values are set).

Regarding claim 6, Lane discloses rotary head comprising a first head capable of reproducing said search video data and a second head incapable of reproduction (see col. 4 lines 14-23); and

said second generating means further comprising a second setting means for setting count value of said counting means on the basis information reproduced from said magnetic tape through said second head (see col. 5 lines 1-19 and col. 7 lines 44-46).

Regarding claim 7, Lane discloses second generating means further comprises a second setting means for setting, on the basis of the count value of said counting means and reproduced information from said track recorded with said search video data, the count value of said counting means (see rejections of claims 5 and 6 and col. 3 lines 50-54 and 59-67 and col. 5 lines 1-19).

Regarding claim 8, Lane discloses reproduced information from said track recorded with said search video data is reproduced information that is obtained when the count value of said counting means is value which corresponds to said track recorded with said search video data (see col. 8 lines 52-67).

Regarding claim 9, Lane discloses the reproduced information from said track recorded with said search video data number recorded on said track (see col. 8 lines 52-67), and

said second setting means sets the count value of said means on the basis of a difference between the count counting value said counting means and said number (see col. 9 lines 4-32).

Claim 13 is rejected for the same reason as discussed in claim 4 above.

Claim 14 is rejected for the same reason as discussed in claim 5 above.

Claim 15 is rejected for the same reason as discussed in claim 6 above.

Claim 16 is rejected for the same reason as discussed in claim 7 above.

Claim 17 is rejected for the same reason as discussed in claim 8 above.

Claim 18 is rejected for the same reason as discussed in claim 9 above.

Claim 19 is rejected for the same reason as discussed in claim 4 above.

8. Claims 11, 12, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane.

Regarding claims 11 and 12, the limitations in claims 11 and 12 can be found in the apparatus claim 1. However claims 11 and 12 further require a recording medium storing a computer readable program, and causing a computer for controlling tracking of tracks on a magnetic tape by rotary head to execute steps as claimed in claim 1. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Lane by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the apparatus claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Regarding claims 20 and 21, the limitations in claims 20 and 21 can be found in apparatus claim 4. However claims 20 and 21 further require a recording medium storing a computer readable program, and causing a computer for controlling tracking of tracks on a magnetic tape by rotary head to execute steps as claimed in claim 4. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching

Art Unit: 2616

of Lane by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the apparatus claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU, HELEN whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, NGOC Y. VU can be reached on 571 272 7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
September 19, 2005


NGOC YEN VU
PRIMARY EXAMINER